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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,438	11/30/2004	Kassim Juma	1488(04-79)	5503
30030 7590 05/05/2008 JAMES R. WILLIAMS 3103 WILMINGTON ROAD NEW CASTLE, PA 16105			EXAMINER KURTZ, BENJAMIN M	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 05/05/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



### Office Action Summary

**Application No.**

10/516,438

**Applicant(s)**

JUMA, KASSIM

**Examiner**

BENJAMIN KURTZ

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



### **DETAILED ACTION**

Claims 12-26 are pending, claims 1-11, 27 and 28 are canceled and claims 12 and 22 are currently amended.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 12-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of the filter comprising a bonded network of graphitizable carbon present up to 15% by weight is not enabled by the specification. The specification recites the bonded network being a graphitized carbon network (abstract, pg. 8, lines 29-30, pg. 11, line 1, and pg. 13, lines 22-23). The term graphitizable refers to a precursor that is heated to make the graphitized carbon network. The specification teaches that the graphitizable carbon is graphitized to make the final filter device, therefore, there is no support for the specific % content of graphitizable carbon. The specification appears to only provide support for 15% by weight of graphitized carbon.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daussan et al. US 5 690 161 in view of Morris et al. US 5 785 851 and Jones et al. US 5 520 823.**

Regarding claims 12 and 20, Daussan teaches a filter device (1b) comprising a protruding frame (11) joining a plurality of sieve plates (2a), the protruding frame and sieve plates defining a reservoir chamber (6) (fig. 3). Daussan does not teach a bonded network of graphitized carbon or each plate including a corrugated surface.

Jones teaches a filter comprising a bonded network of graphitized carbon in a positive amount up to 15% by weight and a ceramic raw material (col. 2, lines 9-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the graphitized carbon network of Jones because the material does not pick up moisture from the atmosphere and has superior strength at ambient and elevated temperatures than prior art filters (col. 4, lines 13-23).

Morris teaches a filter device with a plate including a corrugated surface (fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use corrugation because the inlet surface has a large contact area which



significantly increases the filtration capacity of the filter and the flow rate of the fluid passing therethrough (col. 1, lines 45-55). 'For molten steel filtration' is intended use.

The newly presented claims are product by process claims; however, they do not overcome the product of the currently cited references. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USDQ 964 (1985).

Applicant argues the process of Jones does not use a non-oxidizing and/or reducing atmosphere during the firing process. Jones does not teach the atmosphere is an oxidizing atmosphere and instead teaches the steps must be taken to prevent oxidation such as by adding silicon (column 3, lines 13-26 and 56-61 of Jones). Applicant also argues the product of Jones is different because Jones uses a starting product of graphite rather than graphitizable carbon. However, applicant's specification provides support only for the end product containing a graphitized carbon which Jones contains in the final product.

Regarding claims 13 and 14, Morris teaches the corrugated surface but does not teach a specific dimension of the corrugation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a suitable corrugation within the claimed range to optimize the filter, absent a showing of unexpected results by using the claimed range.



Regarding claims 15-19, Daussan further teaches each sieve plate defines a plurality of through holes (3) and the through holes of a first plate are spaced laterally from the through holes of a second plate (fig. 3); the through holes comprise a circular shape (fig. 2); and the sieve plates include substantially an identical geometry (fig. 3). Daussan teaches the effectiveness of any filter depends essentially on the diameter of the holes and the number of plates (col. 2, line 66 – col. 3, line 6), and if the diameter of the holes is less than 1mm filtration takes a long time and clogs easily. It would have been obvious to one of ordinary skill in the art to optimize the range of hole sizes in, view of the teachings of Daussan, to the claimed ranges as they are greater than 1mm and to filter out the desired sized particles.

Regarding claim 21, Daussan further teaches the filter material includes reinforcing fiber (col. 3, lines 43-44).

**Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones '823 in view of Daussan '161 and Morris '851.**

Regarding claim 22, Jones teaches a method for producing a filter device comprising a bonded network of graphitized carbon, the method comprising: pressing a semi-damp mixture comprising ceramic powder and a graphitizable bonding precursor and fibers to obtain a sieve plate having a disk shape, and firing the assembly in a non-oxidizing atmosphere to a temperature up to 1000 deg. C wherein the graphitizable carbon is present in a positive amount up to 15% by weight (col. 2, lines 10-27, col. 3,



lines 13-25). Jones teaches the advantages of using a non-oxidizing atmosphere (col. 3, lines 23-26 and lines 56-61). Jones does not teach the configuration of the plates.

Daussan teaches a filtering device comprising a protruding frame joining a plurality of sieve plates, the protruding frame and sieve plates defining a reservoir chamber with the plates joined by a binder (fig. 3, col. 4, line 66 – col. 5, line 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use make the protruding frame of Daussan because they allow metal to be exposed to treatment material prior to being introduced into a mold (col. 1, line 60 – col. 2, line 2).

Morris teaches a filter device with a plate including a corrugated surface (fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a corrugation because the inlet surface has a large contact area which significantly increases the filtration capacity of the filter and the flow rate of the fluid passing therethrough (col. 1, lines 45-55).

Regarding claim 23, Daussan teaches a binder but does not teach the binder being ceramic or carbon. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the same components that are in the filter and because ceramic and carbon are durable under the operating conditions of the filter.

Regarding claim 25, Jones further teaches the firing occurs between 600-700 deg. C (col. 3, lines 60-61).

Regarding claim 26, the specification defines roughening the surface as 'pressing directly the geometry providing a corrugation or height difference between the peaks



and troughs'. Morris teaches a corrugated surface with height difference between peaks and troughs and is therefore deemed to teach the claimed limitation.

Regarding claim 24, Jones teaches the advantages of using a non-oxidizing atmosphere for the step of firing the assembly (col. 3, lines 23-26 and lines 56-61). Jones does not teach a reducing atmosphere. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a reducing atmosphere as it is a non-oxidizing atmosphere and will not adversely affect the firing process.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 22-26 have been considered but are moot in view of the new ground(s) of rejection.
4. Applicant's arguments filed 3/11/08 have been fully considered but they are not persuasive. The arguments are addresses in the rejection above.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not



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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN KURTZ whose telephone number is (571)272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin Kurtz  
Examiner



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5/1/08        /BK/

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797